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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,388	07/31/2002	Warrick Smith		5133

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EXAMINER

GLESSNER, BRIAN E

ART UNIT PAPER NUMBER

3635

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,388

Applicant(s)

SMITH, WARRICK

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-29 and 33-38 is/are rejected.
- 7) ☒ Claim(s) 30-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

The following office action is in response to the amendment filed on March 7, 2005. The examiner would like to point out that he made a mistake in the previous office action. The examiner examined claims 35-38 as being dependent upon claim 34. However, claims 35-38 are actually dependent upon claim 25. The examiner also made a typographical error on pages 2 and 3 of the rejection in the paragraphs pertaining to the claim numbers being rejected by Sorton and Fawcett. Since the examiner made the above errors, this rejection will be non-final.

Specification

The disclosure is objected to because of the following informalities: The disclosure does not contain headings to distinguish the various parts of the specification such as "Background of the Invention", "Summary of the Invention", "Brief Description of the Drawings", etc.

Appropriate correction is required.

The substitute specification submitted on December 21, 2004 has not been entered because the applicant did not provide a marked-up copy of the specification showing the changes made. The applicant also did not state that the substitute specification contains no new matter.

Claim Rejections - 35 USC § 102

Claims 25-29 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Sorton (4,947,616).

In regard to claim 25, Sorton discloses a magnetic holding device comprising an elongate member 14 including at least one magnet 46 and having a substantially flat magnetic surface on or in close proximity to the magnet, wherein the elongate member is capable of holding material between said magnetic surface and a magnetically receptive surface, at least one retaining member 12 is provided on the elongate member, the retaining member having a retaining surface extending from the elongate member at an angle to the substantially flat magnetic surface.

In regard to claims 26 and 27, Sorton discloses the claimed invention, wherein the retaining member is integrally attached to the elongate member.

In regard to claim 28, Sorton discloses the claimed invention, wherein the retaining member is adjustable having a lip part movable between an extended position in which the lip part presents a retaining surface extending outwardly from the elongate member generally perpendicularly to the substantially flat magnetic surface, and a retracted position. The examiner would like to point out that the retaining member could be rotated so that its longitudinal axis is parallel with the longitudinal axis of the magnetic member. This could be the "retracted" position. The member could be rotated by loosening the nut on the member 32 enough to allow the members 28, 30 to come out of slot 34.

In regard to claim 29, Sorton discloses the claimed invention, wherein the elongate member comprises a housing containing at least one pair of magnets 46 at longitudinally spaced apart positions of the elongate member, figure 4.

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In regard to claim 35, Sorton discloses the claimed invention, wherein the elongate member is made of wood, col. 2, lines 51-52.

In regard to claims 36-38, Sorton discloses the claimed invention, wherein the at least one magnet is mounted on a surface in a recess of the elongate member, wherein the magnet forms substantially a flat magnetic surface of the device.

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Fawcett et al. (5,904,096).

In regard to claim 34, Fawcett discloses a magnetic holding device comprising an elongate housing member 2 containing at least one pair of magnets 9 at longitudinally spaced apart positions of the elongate housing member, and ferromagnetic material 10 extending between the pair of magnets within the housing. Since the material 10 is larger than the magnets, at least a portion of it is located, or extends between adjacent magnets.

Claim Rejections - 35 USC § 103

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorton (4,947,616) in view of Fawcett et al. (5,904,096).

In regard to claim 33, Sorton discloses the claimed invention except for specifically disclosing the use of ferromagnetic material between at least one pair of magnets. Fawcett teaches the use of ferromagnetic material 10 in combination with magnets. It would have been obvious to one having ordinary skill in the art to use ferromagnetic material in Sorton's invention, because said material will create a stronger magnetic bond between the magnets and the objects that are to be held.

Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen (5,313,754).

In regard to claims 20-24, Jensen discloses a method of attaching a sheet material (figure 1) to a structure, said method comprising the steps of providing a magnetic holding device 10 comprising a housing 18 including at least one magnet 24 and having a substantially flat magnetic surface on or in close proximity to said magnet, placing a sheet material, figure 1, against at least one magnetically receptive surface 16 of the structure, placing said magnetic holding device with said flat magnetic surface against the sheet material to hold the sheet material in place between the magnetic surface and the magnetically receptive surface of the structure so that the sheet material can be secured to the structure. The holding device comprises an elongate member including a plurality of magnets located at spaced intervals along the elongate housing. The holding device also comprises at least one retaining member 20 having a part with a retaining surface extending from the housing at an angle to the substantially flat magnetic surface for engagement with a surface of one of the frame members extending at an angle to the magnetically receptive surface of the frame member. Jensen does not specifically disclose that a plurality of devices are used. It would have been obvious to use more than one device, because there is usually a plurality of corners in a structure, and each corner would have the magnetically receptive surfaces, which are comprised of ferromagnetic material. Therefore, it would have been obvious to use a plurality of devices to hold the sheet material between said ferromagnetic material and the device.

Allowable Subject Matter

Claims 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

In regard to applicant's argument that Sorton does not disclose that his device is capable of holding a sheet material to a structure, the examiner would like to point out that this is a functional limitation. Therefore, as long as Sorton's device is capable of performing the function, the claimed limitations are met. Sorton discloses all of the structural features of the claim. Therefore, his device is inherently capable of performing the function of holding a sheet material in place.

In regard to the applicant's argument that Fawcett does not disclose that the ferromagnetic material extends between the magnets, the examiner respectfully disagrees. As pointed out in the above rejection, Fawcett does disclose that the ferromagnetic material extends at least partially between the magnets. The ferromagnetic material does not extend from one magnet to the next, but the claim does not claim that it has to. Therefore, Fawcett's ferromagnetic material meets the applicant's claimed limitations.

In regard to the method claims, the applicant argues that Jensen does not disclose that the device holds the sheet material in place. The examiner respectfully

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disagrees. Even the Jensen uses the device to protect the sheet material at the corner the device is still helping to support the sheet material against the support because the sheet material is clamped between the support and the device. Therefore, the claimed limitations are met.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 571-272-6843. The examiner can normally be reached on Monday through Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brian E. Glessner
Primary Examiner
Art Unit 3635

B.G.
April 16, 2005